

### **REMARKS/ARGUMENTS**

The rejections presented in the Office Action dated November 6, 2006 (hereinafter Office Action) have been considered. Claims 1-67 are pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claim 68 has been added. Support for the claim can be found in the Applicant's Specification at, for example, Page 29, Lines 10-14. Accordingly, no new matter has been added.

The status of claims 16-67 has been changed to "Withdrawn." As such, the Applicant requests that the Examiner withdraw the objection to claims 16-67. In addition, the Applicant reserves the right to continue to contest the propriety of the restriction requirement, whether by petition or other appropriate means.

The Applicant respectfully requests that the Examiner reconsider the propriety of the restriction requirement and the withdrawal of claims 16-67, at least as to the restriction requirement between Inventions I (claims 1-15) and II (claims 16-36). In the Examiner's discussion of the restriction requirement on page 2, the Examiner states that "[a]s claimed, group I applies to delivery of pacing therapy in response to detection of cardiac asystole only (lines 14-15 of the claim), whereas claim 16 applies to delivery of pacing therapy in response to any cardiac condition."

The Applicant respectfully disagrees with the Examiner's characterization of claim 16. For example, contrary to the Examiner's statement that "claim 16 applies to delivery of pacing therapy in response to any cardiac condition," claim 16 recites "the energy delivery circuitry configured to deliver only two forms of cardiac therapy, the two forms of cardiac therapy comprising a therapy to treat a tachyarrhythmia and a pacing therapy deliverable at a rate lower than a bradycardia pacing rate." (Emphasis added in both quotations).

The Examiner's attention is directed to antecedent basis for the phrase "the pacing therapy" in line 15 of claim 16. Antecedent basis for the phrase "the pacing therapy" is found in lines 6 and 7 of claim 16—"a pacing therapy deliverable at a rate lower than a

bradycardia pacing rate.” Hence, the pacing therapy of claim 16 is limited to those that are deliverable at a rate lower than a bradycardia pacing rate in response to detection of a cardiac condition requiring treatment by use of such a “lower-than-bradycardia” pacing therapy. As such, the basis for the restriction requirement is in error and the restriction requirement should be withdrawn.

Moreover, other inconsistencies in the basis for the restriction requirement remain unresolved. For example, independent claims 1 and 16 are both directed to systems for preventing sudden cardiac death. Both claims 1 and 16 recite control circuitry for coordinating delivery of tachyarrhythmia therapy and asystole preventative pacing, differing in the manner in which the asystole preventative pacing is described, yet a restriction was drawn between claims 1 and 16.

Claim 1 recites “non-physiologic, life sustaining pacing therapy” while claim 16 recites “pacing therapy deliverable at a rate lower than a bradycardia pacing rate.” The Applicant respectfully submits that the phrases “non-physiologic, life sustaining pacing therapy” and “pacing therapy deliverable at a rate lower than a bradycardia pacing rate” both refer to asystole therapies in the context of the disclosure. For example, the specification states that “[i]n an embodiment in which asystole prevention pacing is also made available, the SCDP device 502 produces pacing pulses in accordance with a non-physiologic, life sustaining pacing therapy, such as pacing therapy deliverable at a rate lower than a bradycardia pacing rate.” (Page 20, Lines 15-18; emphasis added).

Restriction is improper unless a separate utility for each invention is identified. (MPEP § 806.05(c)). On pages 2 and 4 of the Office Action mailed September 18, 2006, the Examiner contends that “[t]he subcombination [of Invention I, claim 1] has separate utility [from Invention II, claim 16] such as treatment of asystole . . . .” For reasons discussed above, the Applicant respectfully submits that the Examiner has not met her burden of identifying a viable separate utility as is required by the MPEP, but rather has identified a utility common to both Inventions I (claims 1) and II (claim 16). As such, the Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement at least as to Inventions I and II.

Claims 1-12 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,074,301 to *Gill* (hereinafter "*Gill*").

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102. The Applicant respectfully submits that *Gill* does not teach each and every element of independent claim 1, and therefore fails to anticipate this claim.

*Gill* discloses an apparatus for delivering bradycardia pacing. (Col. 6, Lines 37-38). *Gill* does not disclose pacing at a rate lower than bradycardia pacing.

The Applicant's independent claim 1 recites "delivery of the non-physiologic, life sustaining pacing therapy in response to detection of cardiac asystole." The Applicant's Specification specifically identifies "non-physiologic, life sustaining pacing therapy" as pacing at a rate lower than bradycardia pacing. ("[i]n an embodiment in which asystole prevention pacing is also made available, the SCDP device 502 produces pacing pulses in accordance with a non-physiologic, life sustaining pacing therapy, such as pacing therapy deliverable at a rate lower than a bradycardia pacing rate." Specification, Page 20, Lines 15-18). As such, *Gill* does not teach each and every element and limitation of independent claim 1 and cannot support an anticipation rejection of the claim.

Dependent claims 2-12, which are dependent from independent claim 1, were also rejected under 35 U.S.C. §102(b) as being unpatentable over *Gill*. While the Applicant does not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made in connection with independent claim 1. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited reference. Therefore, dependent claims 2-12 are also not anticipated by *Gill*.

For at least these reasons, the Applicant respectfully submits that the rejection of claims 1-12 as being anticipated by *Gill* is not sustainable.

Claims 13-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Gill*.

Each of claims 13-15 depend from independent claim 1. Independent claim 1 is not obvious for at least the reason that *Gill* fails to teach or suggest each and every limitation recited in independent claim 1. Furthermore, while the Applicant does not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made in connection with independent claim 1. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited reference. Moreover, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent claims 13-15 are not made obvious by *Gill*.

As such, the Applicant respectfully requests withdrawal of the §103(a) rejection of claims 13-15 and notification that these claims are in condition for allowance.

It is to be understood that the Applicant does not acquiesce to the Examiner's characterization of the asserted art or the Applicant's claimed subject matter, nor of the Examiner's application of the asserted art or combinations thereof to the Applicant's claimed subject matter. Moreover, the Applicant does not acquiesce to any explicit or implicit statements or conclusions by the Examiner concerning what would have been obvious to one of ordinary skill in the art, obvious matter of design choice, or known in the art. The Applicant respectfully submits that a detailed discussion of each of the Examiner's rejections beyond that provided above is not necessary, in view of the clear absence of teaching and suggestion of various features recited in the Applicant's pending claims. The Applicant, however, reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

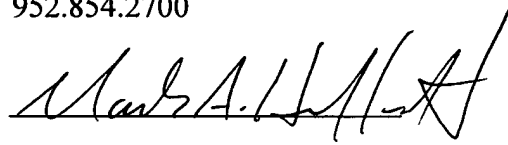
Authorization is given to charge Deposit Account No. 50-3581 (GUID.119PA) any necessary fees for this filing, including additional claim fees. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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Date: January 25, 2007

By:

A handwritten signature in black ink, appearing to read "Mark A. Hollingsworth", written over a horizontal line.

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